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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,346	10/07/2003	Harald Walter	PF/5-31300B/D1	5652

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SYNGENTA CROP PROTECTION, INC.
PATENT AND TRADEMARK DEPARTMENT
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EXAMINER

GRAZIER, NYEEMAH

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,346	Applicant(s) WALTER ET AL.	
	Examiner Nyeemah Grazier	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

I. ACTION SUMMARY

Claims 1-14 are currently pending in the instant application and are subject to the required restrictions and elections as described below.

II. PRIORITY

This is a U.S. Divisional Application of U.S. Application 10/181,702, filed October 8, 2002, now U.S. Patent 6,806,286. This application claims the benefit to its patent application U.S. Application 10/181,702, filed on October 8, 2002. The instant application also claims foreign priority to United Kingdom Application No. 0001447.2, filed January 21, 2000. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/181,702, filed on October 8, 2002.

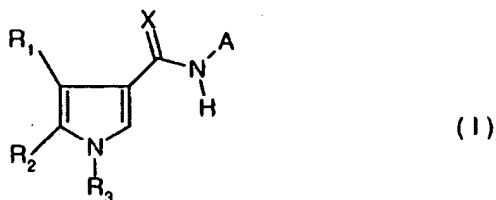
III. RESTRICTION

The Markush group set forth in the claims includes both independent and distinct inventions, and patentable distinct compounds or species within each invention. However, the instant application discloses and claims a plurality of patentable distinct inventions far too numerous to list individually. Moreover, each of these inventions contain a plurality of patentable distinct compounds, also far too numerous to list individually. Restriction to one of the following Inventions is required pursuant to 35 U.S.C. § 121, wherein an Invention is a set of *patentable distinct inventions* of a broad statutory category.

Restriction to one of the following *exemplary inventions* is required under 35 U.S.C. 121

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- I. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is oxygen, **A** is ortho-substituted phenyl (A1) and **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a cycloalkyl group, classified in various subclasses of various classes such as class 548, subclass 561



- II. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is oxygen, **A** is ortho-substituted phenyl (A1) and **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is thiazolyl, classified in various subclasses of various classes such as class 548, subclass 146+.
- III. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is oxygen, **A** is an ortho-substituted thiazole ring (A2) – (A4), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a phenyl ring, classified in various subclasses of various classes such as class 548, subclass 146+
- IV. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is oxygen, **A** is an ortho-substituted furan ring (A5) – (A7), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a phenyl ring, classified in various subclasses of various classes such as class 548, subclass 560+
- V. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is sulfur, **A** is an ortho-substituted pyrazole ring (A8) – (A9), **R1**, **R2**, **R3** and **R5** are as defined in

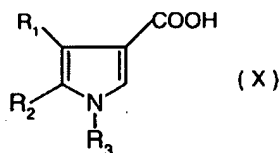
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claim 1 and **R4** is a phenyl ring, classified in various subclasses of various classes such as class 548, subclass 560+.

- VI. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is sulfur, **A** is an ortho-substituted isoxazole ring (A10) – (A12), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is pyridyl, classified in various subclasses of various classes such as class 546, subclass 249+.
- VII. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is oxygen, **A** is an ortho-substituted isothiazole ring (A13) – (A15), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a phenyl ring, classified in various subclasses of various classes such as class 548, subclass 206+.
- VIII. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is oxygen, **A** is an ortho-substituted 1,2,3 thiadiazole ring (A20) – (A21), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a cycloalkyl group, classified in various subclasses of various classes such as class 548, subclass 127.
- IX. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is oxygen, **A** is an ortho-substituted pyridine ring (A22) – (A25), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is oxazolyl, classified in various subclasses of various classes such as class 546, subclass 249+.
- X. Claims 1-9, drawn to the compound of Formula (I) wherein **X** is oxygen, **A** is an isobenzofuran ring (A31), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a phenyl group, classified in various subclasses of various classes such as class 548, subclass 517+.

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- XI. Claim 10, drawn to a process for the preparation of the compound of formula (I) wherein **X** is oxygen, **A** is an ortho-substituted pyridine ring (A22) – (A25), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a phenyl ring, classified in various subclasses of various classes such as class 546, subclass 249+.
- XII. Claims 11, drawn to a composition for controlling microorganisms and preventing infestation of plants wherein the active ingredient is a compound of claim 1 wherein **X** is oxygen, **A** is an ortho-substituted pyridine ring (A22) – (A25), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a phenyl ring, classified in various subclasses of various classes such as class 546, subclass 249+.
- XIII. Claims 12 and 13, drawn to the process of use of the compound of formula (I) wherein **X** is oxygen, **A** is an ortho-substituted pyridine ring (A22) – (A25), **R1**, **R2**, **R3** and **R5** are as defined in claim 1 and **R4** is a phenyl ring, classified in various subclasses of various classes such as class 546, subclass 249+.
- XIV. Claim 14, drawn to the compound of formula (X), classified in class 548, subclass 562.



It should be noted that the abovementioned groups are exemplary and therefore the groups as listed above is not exhaustive.

Markush Claims

A provisional election of a species is required because the Markush-type claims of the instant application include distinct independent inventions. Restriction of a Markush group is proper where the compounds within the group either (1) do not share a common utility, or (2) do not share a substantial structural feature disclosed as being essential to that utility. See In re Harnisch, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); See also Ex Parte Hozumi, 3 USPQ2d 1059 (BPAI 1984). Absent evidence that subject matter of the Markush-type claim lacks unity of invention, the Office may not merely “refuse to examine that which applicants regard as their invention.” See M.P.E.P. § 803.02; In re Harnisch, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility. Additionally, a Markush group may encompass a plurality of independent and distinct inventions where two or more members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the other member(s) obvious under 35 U.S.C. §103. **Therefore, in addition to an election of one of the abovementioned Inventions, restriction is further required under 35 U.S.C. § 121.**

If Invention I is elected, election of a single species is further required, including an exact definition of each substitution on the base molecule, Formula (I), wherein a single member at each substituent group is selected. For example, if a base molecule has a substituent group R1, wherein R1 is recited to be any one of H, OH, COOH, aryl, alkoxy, halogen, amino, etc.,

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Applicant must elect a single substituent of R1, for example OH, and each subsequent variable position. This process is repeated for each variable so that a single compound is identified.

In the instant case, upon election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound. The elected compounds should be similar that they will encompass the same inventive concept and reduction to practice. The scope of an independent invention will encompass all compounds within the scope of the claim, which fall into the same class and subclass as the elected compound, but may also include additional compounds, which fall in related subclasses. Examination will then proceed on the elected compound and the entire scope of the invention encompassing the elected compound as defined by common classification.

A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of compounds along with (if appropriate) the process of using or making said compound under examination. This will be set forth by reference to specific class(es) and subclass(es) examined. Should applicant traverse on the ground that the compound are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the compound to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

All compounds falling outside the class(es) and subclass(es) of the selected compound and any other subclass encompassed by the election above will be directed to nonelected subject

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matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R. 1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications.

Applicant is reminded that upon cancellation of claims to a nonelected invention, the inventions must be amended in compliance with 37 C.F.R. 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(i).

Applicants can review the claims and disclosure to determine the scope of the invention and can set forth a group of compounds, which are so similar, within the same inventive concept and reduction to practice. Markush claims require sufficient support in the disclosure for each member of the Markush group. See MPEP § 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the core structure as the selected species must be consistent with the written description.

Rationale Establishing Patentable Distinctiveness Within Each Group

Invention I-X and XII are unrelated compounds. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, functions or effects (MPEP 806.04, 808.01). In the instant case, the claims of invention I-X and XII are drawn to compounds with different structures, which are classified in different classes and subclasses as indicated above.

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Inventions I-X and XII are related to Invention XI as product and product by process. However, the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for making the product as claimed can be used to make a materially different product or (2) the product as claimed can be made by a materially different process of using that product M.P.E.P. § 806.05. In the instant case, the process for preparing the materially different products is accomplished by using materially different reagents, H₂NA wherein A are materially different aryl rings.

Inventions I-X and XII are related to Invention XIII as a product and a method of use. However, the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with a materially different product or (2) the product as claimed can be used by a materially different process of using that product M.P.E.P. § 806.05. In the instant case, the method of protecting plants against infestation can be accomplished with products other than the product of Formula (I).

Inventions I-X and XII and XIV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP 806.04(h)). In the instant case, the intermediate product is deemed to be useful as intermediates in the preparation of compounds of formula (I), which is useful in the treatment of plant infestation and the inventions are deemed patentably distinct because there is nothing on the record to show them to be obvious variants. Should applicants traverse on the grounds of distinctiveness, applicant should submit evidence or identify the evidence of record showing the species to be obvious variants or clearly admit on the

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record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 USC 103(a) of the other invention.

Additionally, because of the plethora of classes and subclasses in each of the Inventions, a serious burden is imposed on the examiner to perform a complete search of the defined areas. Lack of restriction would impose a serious burden on the Examiner. Thus, based on the abovementioned rationale, the restriction as set forth in the instant application is proper.

In sum, each Group listed above has a diverse chemical structure, different chemical properties, different modes of action, and different effects and reactive conditions and is therefore recognized in the art as being distinct from one another. MPEP §§ 806.04, 808.01. Additionally, the level of skill in the art is not such that one invention would be obvious over the other invention (Group), i.e. they are patentable over each other. Chemical structures, which are similar, are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly. The rebuttable presumption, that similar chemical structures behave similarly, may be overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holding of Application of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Lalu, 223 USPQ 1257 (Fed. Cir. 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

Advisory of Rejoinder

The Examiner has required restriction between a product and method of use claims.

Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejections are governed by 37 CFR 1.116; amendments submitted after allowances are governed by 37 CFR 1.312.

The following is a recitation of M.P.E.P. 821.04, Rejoinder:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims, which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims, which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. Amendments submitted after final rejection are governed by 37 CFR 1.116. Process claims which do not depend from or otherwise include the limitations of the patentable product will be withdrawn from consideration, via an election by original presentation (see MPEP § 821.03). Amendments submitted after

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allowance are governed by 37 CFR 1.312. Process claims which depend from or otherwise include all the limitations of an allowed product claim and which meet the requirements of 35 U.S.C. 101, 102, 103, and 112 may be entered.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either: (A) elect the invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2); or (B) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2) even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26(a) states that "[T]he Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee...will not entitle a party to a refund of such fee..." In this case, the fees paid under 37 CFR 1.129(b) were not paid by mistake nor paid in excess, therefore, applicant would not be entitled to a refund. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action. Form paragraphs 8.42 through 8.44 should be used to notify applicant of the rejoinder of process claims which depend from or otherwise include all the limitations of an allowable product claim.

In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104 - 1.106. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

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The following is a recitation from paragraph five, "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. §103(b)" (1184 TMOG 86(March 26, 1996)):

"However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim **depends from or otherwise includes all the limitations of** an allowed product claim. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined." (emphasis added)

Pursuant to M.P.E.P. § 821.04 and In re Ochiai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Telephone Inquiry

During a telephone conversation with Rose Allen, Esquire on July 6, 2005 to request an oral election to the above restriction requirement, but did not result in an election.

III. CONCLUSION

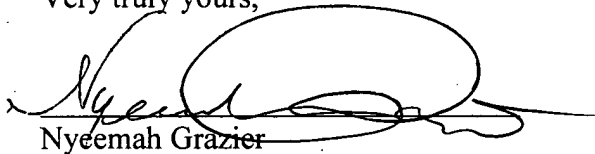
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Friday from 8:30 a.m. - 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

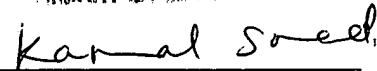
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Very truly yours,


Nyeemah Grazier

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